

R E M A R K S

The claims have been amended, in part, to replace dated nomenclature with the more standard nomenclature that is now being used. While the originally used nomenclature would be readily understood by a chemist reading the specification, Applicants believe that the newer nomenclature would be preferred. Specifically, "p-tolyl" has been replaced with "4-methyl-phenyl". "Furfuryl" has been replaced with "furan-2-yl-methyl" and "picolyl" has been replaced with "pyridinyl-methyl". These amendments in no way add new matter to the specification or change the scope of the claims since the amended nomenclature is synonymous with the original wording and would be readily recognized as such by one of ordinary skill in the art.

Rejections under 35 U.S.C. §112, first paragraph

The Examiner maintains the rejection of claims 1, 2, 4-6, 8, 9 and 15 under 35 U.S.C. §112, first paragraph for lack of enablement. The Examiner further maintains the rejection of claims 24 and 25. The Examiner maintains the rejection based on the definition of R1 and R2 and the definition of R3 and R4. Applicants traverse these rejections and withdrawal thereof is respectfully requested.

a) Regarding the rejection over the definition of R1 and R2 in the claims, the Examiner has provided no comments. On page 3, final paragraph, the Examiner appears to have repeated the original rejection with regard to R1 and R2. Applicants request that the Examiner either withdraw the rejection or specifically address why she finds the significantly narrowed definition of R1 and R2 lacking in enablement.

b) Regarding R3 and R4, the Examiner states that the specification is not enabled for all the possible heterocyclic 6-9-membered rings, which form the diester of formula III. As with R1 and R2, the Examiner has not provided any specific comments as to why she considers that R3 and R4 to lack enablement. On page 4, the Examiner repeats the previous remarks regarding R3 and R4.

c) Rejection of claims 24 and 25 - The Examiner similarly maintains the rejection of claims 24 and 25 without addressing Applicants' arguments.

The Examiner is procedurally incorrect in maintaining her position. As discussed in the response of September 4, 2003, the Examiner has failed to properly examine the present application.

The rejection for lack of enablement in the Office Actions issued on June 4, 2003 and November 17, 2003 appear to be nearly verbatim repeats of the final Office Action January 14, 2003. There

is no apparent consideration or discussion of Applicants' arguments. Such action by the Examiner is improper and prejudicial to Applicants by prolonging the examination of the application and shortening any potential patent term. The Examiner is directed to M.P.E.P. §707.07(f), which very explicitly instructs, "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." (emphasis added). The Examiner has failed to answer the substance of Applicant's arguments.

As noted previously, the Examiner still has not supported her position for lack of enablement with any evidence and simply makes conclusory assertions regarding each Wands factor. M.P.E.P. §2164.04 discusses the burden upon the Examiner when making a rejection for lack of enablement. As such, the rejections of the claims for lacking enablement are improper and withdrawal thereof is respectfully requested.

As indicated above, the rejections of the claims are improper and lacking foundation. However, in an effort to expedite the allowance of claims, the claims have been amended as indicated above to specifically define the substituents as those exemplified in the specification and the preferred analogs of claims 7, 9, 10

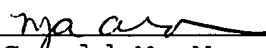
and 14. As such, withdrawal of the rejection is respectfully requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact MaryAnne Armstrong, PhD (Reg. No. 40,069) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
Gerald M. Murphy, Jr., #28,977

MaryAnne Armstrong, PhD #40,069

GMM/MAA/bsh
2815-0159P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000